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10/580,997

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EXAMINER

VAUGHAN, MICHAEL R

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/580,997 | Applicant(s) MADAR ET AL. | |
| | Examiner MICHAEL R. VAUGHAN | Art Unit 2431 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The instant application having Application No. 10/580,997 is presented for examination by the examiner. Claims 1-20 are pending.

Response to Arguments

Applicant's arguments filed 3/11/11 have been fully considered but they are not persuasive. Applicant alleges that prior art Setogawa fails to teach said password menu screen prompts said user to input said password if playback of said selected recording title is attempted. This newly amended limitation adds functionality to the password menu screen. However, the password menu screen is taught by the prior reference Tsurui. As such, Tsurui was relied upon to teach the password menu screen. Specifically, Tsurui teaches said password menu screen prompts said user to input said password if playback of said selected recording title is attempted (0047). All that was relied upon from Setogawa was that using a single program chain is more efficient than using a plurality of program chains and menus can be stored along with the title (col. 13, lines 1-5). Therefore, the argument as to whether Setogawa teaches the newly incorporated limitation is moot.

As mentioned above, Setogawa teaches a single program chain is more efficient and that menus can be stored in the same program chain as the title. Sugahara teaches the password and title can both be stored in the in a single program chain.

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Thus one of ordinary skill in the art can combine known teachings which produce predictable results. This combination would not have led to unpredictable results such as nonconformance to the DVD standard. As such, Examiner respectfully maintains the combination above renders the claimed invention obvious under 35 USC §103.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan Patent Publication 2003-132624 to **Tsurui** in view of USP Application Publication 2002/0146238 to **Sugahara** and USP 6,469,718 to **Setogawa** et al., hereinafter Setogawa.

As per claims 1 and 8, Tsurui teaches a method and a digital recording and playback apparatus comprising:

enabling a user to record digital signals onto a digital storage medium in a first program chain for password protection said first program chain being a single program chain according to DVD specifications (0030-0031);

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receiving a password from said user for said selected recording title (0033);
storing said password for said selected recording title on said digital storage medium (0051);

storing a password menu screen for said selected recording title on said digital storage medium (0033-36) wherein said password menu screen prompts said user to input said password if playback of said selected recording title is attempted (0047); and

requiring said password to be input before playing back said selected recording title (0030). Tsurui teaches the password is stored in a PGC which includes the program for driving the password input menu (0037). Tsurui teaches a separate single PGC for playing back the selected title [collation program utilized to play back the picture/audio data; 0030] which is invoked by PGC which calls the video in its post command (0042). Therefore Tsurui is silent in disclosing storing the selected recording title, the password menu, and the password in a single PGC. Tsurui teaches several program chains linking to each other in order to carry out the password entry for the selected recording title.

First of all, Tsurui adheres strictly to the DVD specification. Sugahara teaches a similar system in which a PGC which calls list information includes both the password, address of the title, and the title (0088 and 0089). In paragraph 0013-14 Sugahara describes the nature of what PGC do, namely they prescribe the order by which content is displayed. Sugahara teaches that list information blocks perform the same function (0018). The list information even has cells which PCG also have. Clearly list information and PGC are equivalent. What is unique in Sugahara is that both the

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selected title (program number), relative address (pointer to the video content), and the password for that number are stored in the same cell of a single list information (PGC) (0089). Sugahara does this to protect the individual content with a password to prevent others from viewing the content. This is the same reasoning for the passwords of Tsurui. Only this method yields a more granular means of control over the content. One of ordinary skill could have stored the password in the same single PGC as the title without parting from the invention's purpose. A single PGC, with its cells, could store the password and the title for said title.

Thus the combination of Tsurui clearly shows it is obvious to store password with the title in a single program chain. This just leaves the location of the password menu. Prior art Setogawa further teaches that using a single program chain is more efficient than a plurality of program chains because access time is decreased with the PGC data including menus can be read once sequentially (col. 13, lines 1-15). Tsurui already teaches the password is stored with the menu (0037) and Sugahara teaches the password can be stored with the title in a single program chain. Thus incorporating the fact that it is more efficient to store everything in one program chain, one of ordinary skill in the art could have tried storing the title, password, and menu in one program chain. As long as doing so does not conflict the DVD specification, there are no unpredictable results. All three references operate within the DVD specification. After reviewing the claims and the prior art, Examiner finds the notion of using one or more program chains moot. One of ordinary skill in the art could have used or tried any number of program chains to implement a password protected DVD as a matter of common sense. Tsurui

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clearly shows it is possible to do so while adhering to the DVD specification. More over, because a program chain is simply made up of any number of cells, the very nature of a chain with links obviously lends itself to the idea that one could simply make a longer chain. Absent any unpredictable result, Examiner does not see why one of ordinary skill in the art could not have placed the title, password, and menu in one program chain. As such, the claim is obvious because one of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. Since placing the title, menu, and password leads to anticipated success (less delay while adhering to the DVD specification), it is likely the product not of innovation but of ordinary skill and common sense.

As per claim 16, Tsurui teaches a digital storage medium, comprising:

a plurality of data fields [DVD standard] (0027); and

wherein said data fields comprise a first program chain [PCG#10] for storing a selected recording title the program chain being according to DVD specification (0030).

Tsurui teaches the password is stored in a PGC which includes the program for driving the password input menu (0037) said password menu screen prompts said user to input said password if playback of said selected recording title is attempted (0047).

Tsurui teaches a separate single PGC for playing back the selected title [collation program utilized to play back the picture/audio data; 0030] which is invoked by PGC which calls the video in its post command (0042). Therefore Tsurui is silent in disclosing storing the selected recording title, the password menu, and the password in

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a single PGC. Tsurui teaches several program chains linking to each other in order to carry out the password entry for the selected recording title.

First of all, Tsurui adheres strictly to the DVD specification. Sugahara teaches a similar system in which a PGC which calls list information includes both the password, address of the title, and the title (0088 and 0089). In paragraph 0013-14 Sugahara describes the nature of what PGC do, namely they prescribe the order by which content is displayed. Sugahara teaches that list information blocks perform the same function (0018). The list information even has cells which PCG also have. Clearly list information and PGC are equivalent. What is unique in Sugahara is that both the selected title (program number), relative address (pointer to the video content), and the password for that number are stored in the same cell of a single list information (PGC) (0089). Sugahara does this to protect the individual content with a password to prevent others from viewing the content. This is the same reasoning for the passwords of Tsurui. Only this method yields a more granular means of control over the content. One of ordinary skill could have stored the password in the same single PGC as the title without parting from the invention's purpose. A single PGC, with its cells, could store the password and the title for said title.

Thus the combination of Tsurui clearly shows it is obvious to store password with the title in a single program chain. This just leaves the location of the password menu. Prior art Setogawa further teaches that using a single program chain is more efficient than a plurality of program chains because access time is decreased with the PGC data including menus can be read once sequentially (col. 13, lines 1-15). Tsurui already

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teaches the password is stored with the menu (0037) and Sugahara teaches the password can be stored with the title in a single program chain. Thus incorporating the fact that it is more efficient to store everything in one program chain, one of ordinary skill in the art could have tried storing the title, password, and menu in one program chain. As long as doing so does not conflict the DVD specification, there are no unpredictable results. All three references operate within the DVD specification. After reviewing the claims and the prior art, Examiner finds the notion of using one or more program chains moot. One of ordinary skill in the art could have used or tried any number of program chains to implement a password protected DVD as a matter of common sense. Tsurui clearly shows it is possible to do so while adhering to the DVD specification. Moreover, because a program chain is simply made up of any number of cells, the very nature of a chain with links obviously lends itself to the idea that one could simply make a longer chain. Absent any unpredictable result, Examiner does not see why one of ordinary skill in the art could not have placed the title, password, and menu in one program chain. As such, the claim is obvious because one of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. Since placing the title, menu, and password leads to anticipated success (less delay while adhering to the DVD specification), it is likely the product not of innovation but of ordinary skill and common sense.

As per claims 2, 9, and 17, Tsurui teaches the digital storage medium is a DVD (0030).

As per claims 3 and 10, Tsurui teaches the step of storing at least one command on said digital storage medium in said first program chain (0071).

As per claims 4 and 11, Tsurui teaches at least one command causes said password menu screen to be displayed if playback of said selected recording title is attempted (0040).

As per claims 5 and 7, Tsurui teaches at least one command [commands into collation PGC to check for and guide password entry] is created and stored in response to receiving said password from said user (0035).

As per claim 6, Tsurui teaches wherein said at least one command includes a PRE command according to DVD specification (0041).

As per claims 12, 15, and 19, the combination of Tsuria and Sugahara essentially moves the password and the selected title into a single PGC. Thus, Tsurui teaches creating at least one command [commands into collation PGC to check for and guide password entry] and causes said at least one command to be stored on said digital storage medium in said first program chain in response to an input from said user defining said password (0035). The claim is obvious because this is a predictable result from Tsuria and Sugahara as combined in the rejection of claim 1.

As per claim 13, Tsurui teaches at least one command includes a plurality of commands [chain leads to multiple other commands with there respective pre/post commands; 0042-0046].

As per claim 14, Tsurui a plurality of commands comprise PRE commands according to DVD specifications [chain leads to multiple other commands with there respective pre/post commands; 0042-0046].

As per claim 18, Tsurui teaches said first program chain also stores at least one command [PGC#10; 0046 and Figure 5b].

As per claim 20, Tsurui teaches at least one command causes said password menu screen to be displayed if playback of said selected recording title is attempted (0040) and input of said user-assigned password is required before playing back said selected recording title (0051).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is (571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./

Examiner, Art Unit 2431

/NATHAN FLYNN/

Supervisory Patent Examiner, Art Unit 2431